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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,801	07/03/2000	Roger P. Hoffman	P/2-63	4244

7590 07/15/2003

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EXAMINER

WEISBERGER, RICHARD C

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

5

<b>Office Action Summary</b>	<b>Application No.</b> 09/609,801	<b>Applicant(s)</b> HOFFMAN, ROGER P.	
	<b>Examiner</b> Richard C Weisberger	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Concur Technologies, Portable Software, Press Release in view of Russell et al. (USP 6,386,453).

It is the claims that define the invention and it is the claimed invention that is compared to the prior art. The PTO applies the broadest reasonable meaning to the language of the claims. Generally words carry their ordinary and customary meaning and limitations of the specification are not read into these meanings. Arguing what is meant by a word in claim is not sufficient and does not substitute for adding a limitation to a claim. Accordingly, based on the interpretations contained herein the for the additional reasons added thereto, the prima facie rejection is made final.

Amended claim 1 relates to a method which requires sweeping a card having a person's email address on said card through a card reader; entering information about the expense into the card reader; and entering the information into fields of the Internet Expense Account. The claim given its broadest reasonable interpretation reads on a

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employee entering information into his XMS account, the account being opened and accessed via a device as taught by the secondary reference.

In response the prima facie office action of claim 1, the applicant argues that XMS software of Concur does not relate to an e-mail address being on a card. The prima facie office action did not state this. Rather, the action relied on the secondary reference for this teaching. Moreover, ample motivation was provided (It would have been obvious for one skilled in the art used this system to initiate the recording the travel and expenses information of the primary reference as motivated by the need to increase efficiency). for combining the first and second references. The applicant next argues that there are no fields which are part of the expense account produced to the user of XMS. Since the term field can be any location in a record (Microsoft Press, Computer Dictionary), this argument is flawed.

In response the prima facie office action of claim 2 and 7, the applicant argues that the primary reference fails to teach "information be entered into the Internet Expense Account comprise information not on the card". This argument is flawed. In the third paragraph. the primary reference teaches a client/server solution, including report preparation (information not on card).

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The applicant argues that the reference fails to teach that the information on the card can not be deleted. This argument is incorrect since the information on the card of the prior art can not be deleted (Russell, Figure 6).

The applicant argues that the reference once combined fail to teach the invention of claim 4. The prima facie office action is based on a broadest reasonable interpretation of claim 4 (a card and a text document). The email address on the card- once scanned- reads on the limitations of the card and the transferring system.

The applicant argues that the references taken as a whole fail to teach that the information from the card cannot be changed in the document. This argument is misplaced. If the information from the card were for example the employee name, it would be obvious for one skilled in the art to make the information, the employee name (to some degree) unchangeable as motivated by the need to reduce theft and improve accuracy.

In response to the argument directed to claim 9, the secondary reference at column 19, line 14, teaches that other types of information can be encoded on the magnetic strip. This information by default is to some degree apart of a separate field in the text document.

With respect to claim 10, the applicant stipulates that the XMS system takes the information from a charge card provides it to the user. However, the applicant argues that the XMS software does not divide the information from the card into separate fields, including travel, food, and accommodations. However, if the user were to first use the card for travel and next for food, etc. and the XMS were to send two separate emails to the user, this would read on the claims given its broadest reasonable interpretation.

With respect to claim 12, the claims given its broadest reasonable interpretation reads on a employee entering information into his XMS account. The account being opened and accessed via a wireless device as taught by the secondary reference.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Respectfully Submitted

By, 

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